

### **REMARKS**

Applicants thank the Examiner for the thorough examination given the present application.

#### **Status of the Claims**

Claims 1 and 7-8 will be pending in the above-identified application upon entry of the present amendment. Claim 1 has been amended. Claim 3 has been cancelled. Claims 7-8 have been added. Support for the recitations in claim 1 can be found in the present specification, *inter alia*, at paragraph [0020] and Example 4. Support for new claim 7 can be found in the present specification, *inter alia*, at paragraph [0025]. Support for new claim 8 can be found in the present specification, *inter alia*, at paragraph [0002]. Thus, no new matter has been added. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

#### **Issues under 35 U.S.C. § 103(a)**

1) Claims 1 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jakobson et al. '719 (US 5,446,719) in view of JP '654 (JP 2001-025654) and Akiyama et al. '357 (US 5,399,357).

2) Claims 1 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '456 (JP 2003-012456) in view of Jakobson et al. '719, Akiyama et al. '357, and JP '654.

3) Claims 1 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '654 in view of Akiyama et al. '357.

Applicants respectfully traverse. Reconsideration and withdrawal of these rejections are respectfully requested based on the following considerations.

#### **Legal Standard for Determining Prima Facie Obviousness**

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148

USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

- (a) determining the scope and content of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating any evidence of secondary considerations.

*Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. See MPEP 2143.03.

#### Distinctions over the Cited References

The cited references disclose a maximum content of oil agent as being 60 wt% (Jakobson et al. '719, col. 5, lines 11-12). In contrast, claim 1 requires that "the oil agent is present in an amount of 70 to 99.8% by weight."

In response to this argument, the Examiner asserts that Jakobson et al. '719 disclose a content of oil agent as being 10-60 wt% and also disclose a content of 10-60 wt% polyglycerol, which the Examiner considers to be an oil component. Thus, the Examiner finds the sum of these two ingredients to meet the amounts of the "oil agent" in claim 1.

Applicants respectfully traverse the Examiner's assertion that polyglycerol is an oil component. Applicants respectfully submit that polyglycerol is a water-soluble substance and not an oil component. Accordingly, the Examiner cannot rely on polyglycerol to obtain the oil content of the present invention. As evidence showing that polyglycerol is a water-soluble substance, enclosed herewith is Babayan, "Journal of Environmental Pathology, Toxicology and Oncology," 6 (3-4), 1986, pages 15-24. The reference states, "The polyglycerols of the various polymer ranges are viscous fluids which are water soluble" (page 15, lines 5-7 from the bottom). In addition, claim 1 explicitly defines the oil agent, which excludes polyglycerol.

Furthermore, amended claim 1 recites that “the polyglycerol medium-chain fatty acid ester is present in an amount of 0.1 to 15% by weight.” In contrast, Example 7 of Jakobson et al. ‘719 provides an amount of 25% by weight. Accordingly, in addition to the amount of oil agent, the present invention is different from the cited references in the amount of polyglycerol medium-chain fatty acid ester.

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be disclosed by the cited references. As discussed above, the cited references fail to disclose all of the claim limitations of independent claim 1. Accordingly, the combinations of references do not render the present invention obvious.

Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejections is respectfully requested. Any contentions of the USPTO to the contrary must be reconsidered at present.

#### **New Claims 7 and 8**

Claims 7-8 have been added for the Examiner's consideration. Applicants respectfully submit that claims 7-8, which depend from independent claim 1, are allowable for the reasons given above. In addition, claims 7-8 recite further limitations which are not disclosed or made obvious by the cited references.

#### **Conclusion**


All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Registration No. 58,258, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

By   
Craig A. McRobbie  
Registration No.: 42,874  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road, Suite 100 East  
P.O. Box 747  
Falls Church, VA 22040-0747  
703-205-8000

Attachment: Babayan, "Journal of Environmental Pathology, Toxicology and Oncology," 6 (3-4), 1986, pages 15-24